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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/524,689   | 01/12/2006  | Dieter Barfurth      | 265280US0PCT        | 9121             |
| 22850  | 7590        | 04/21/2008           |                     |                  |
| OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.<br>1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |             |                      |                     |                  |
| EXAMINER   |             |                      |                     |                  |
| ZIMMER, MARC S   |             |                      |                     |                  |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
| 1796   |             |                      |                     |                  |
| NOTIFICATION DATE  |             | DELIVERY MODE        |                     |                  |
| 04/21/2008   |             | ELECTRONIC           |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/524,689

**Applicant(s)**

BARFURTH ET AL.

**Examiner**

MARC S. ZIMMER

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 10-18 is/are rejected.
- 7) ☒ Claim(s) 5-9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SG/IC)
- Paper No(s)/Mail Date 02/15/05, 12/06/05, 04/11/06

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### ***Claim Analysis***

Applicant is advised that, for the purpose of evaluating the patentability of at least the more broadly-described claims against the prior art, a "vinylalkoxysiloxane" will be considered merely to be a siloxane polymer bearing both vinyl groups and alkoxy groups that are not necessarily on the same silicon atom. Likewise, an alkylalkoxysilane is interpreted as embracing those siloxane polymers having alkyl substituents and alkoxy substituents. This same treatment extends to all of the other combinations of polymers delineated in (b) through (f). Further, insofar as a polysiloxane can certainly have bonded thereto more than just two types of group, the disclosure of a polymer compound having all of the groups mentioned in any of the combinations (a) through (f) may be said to anticipate claim 1 and perhaps some of the dependent claims for which no additional structure is contemplated.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 10-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Petty et al., U.S. Patent # 6,395,856. Petty discloses the preparation of polysiloxane oligomers that, in some instances, contain all of the groups of a particular embodiment of the claimed invention. For example, the compound (m) in column 11, insofar as it claims methacryl, substituents, methyl substituents, and alkoxy substituents, is

considered to anticipate the claimed invention wherein the combination of oligomers is an acrylic alkoxysilane and an alkylalkoxysilane. Likewise, condensate (n) in column 11 anticipates claimed embodiment (e) for similar reasons. In fact, at least embodiments (a) through (e) all appear to be anticipated by one or more of the condensates mentioned by this disclosure. See also condensates (aa) and (gg) in column 15 and condensate (ff) in column 16.

Relevant to the present discussion, it is contemplated in column 2, lines 36-40 and then again in column 22 that the aforementioned condensates may be employed as coupling agents to facilitate the creation of chemical interactions between the filler and polymer components of a filled, free-radically curable polymer composition.

As an aside, there are numerous other references that would serve to anticipate the broadest incarnations of the claimed invention for the reason that they disclose the employment of polymer materials having all of the same types of chemical moiety present in one or more of the organosilicon compound combinations delineated in claim 1. See, for instance, Lien et al., U.S. Patent # 4,528,081, Okinoshima et al., U.S. Patent # 6,312,553, and Horn et al., U.S. Patent # 5,282,998. However, none of these references serve to render unpatentable any but the most general permutations of Applicant's invention. Indeed, they don't even disclose the utilization of the anticipatory compound as a coupling agent and, thus, the Examiner has decided to withhold from making any formal statements of unpatentability over these references in the name of brevity.

***Allowable Subject Matter***

Claims 5-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARC S. ZIMMER whose telephone number is (571)272-1096. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

April 16, 2008

/Marc S. Zimmer/  
Primary Examiner, Art Unit 1796